REMARKS

Reconsideration of the rejection of the claims in this application for the reasons set forth in the Office Action mailed March 23, 2004, Paper Number 13?, is respectfully requested in view of the foregoing amendment of the claims, the enclosed Affidavit Two Under 37 CFR 1.132 of James McLaughlin and the remarks that follow.

Claim 39 has been amended to specify that the emollient oil in the claimed emollient material is macademia seed oil in accordance with page 7, lines 13 – 14, of the specification. Further, Claim 33 has been amended to delete the ratio of emollient material to calcium stearate as being redundant. Claim 42 has been amended to substitute the antecedent term "mixture" for "matter."

Before discussing the Claim Rejections 35 U.S.C. 103, it is considered that a review of the claimed invention is in order. As described by generic Claim 40, the claimed invention relates to a preferred exfoliating composition in the form of a cream or extrudable paste comprising , by weight, 40% to 60% of an emollient material consisting of major proportion of an emollient oil and a minor proportion of a hydrophobic compound selected from the group of C12 to C18 fatty acids, alcohols, esters and mixtures thereof; a water-soluble surface active agent selected from the group of anionic, nonionic, amphoteric, zwitterionic and cationic surfactants in a proportion in the range of 0.4% to 8% by weight sufficient to leave a thin film of emollient on the treated skin without a greasy after-feel upon rinsing said composition from the skin with tepid water and drying; a magnesium or calcium salt of a C14 – C18 monocarboxylic acid in a weight ratio of emollient material to said monocarboxylic acid salt in the range of 4:1 to 2.5:1 that is adequate to produce an extrudable paste or cream; 10% to 45% of skin compatible particulate material comprising a mixture of 8% to 20% of a starch material with a particulate material selected from the group of sodium chloride, pumice, talc and vegetable seed flour; and 0% to 10% of water, said

composition being effective to cleanse and lubricate the skin when it is applied to and massaged into the skin, thereafter rinsed from the skin with tepid water and the skin is dried.

The significant characteristics of the claimed composition are: (1) the form, i.e. extrudable paste or cream; (2) the composition, i.e., a mixture of emollient material, surfactant, a particulate mixture containing starch and a second particulate thickened with a calcium or magnesium fatty acid salt and 0 – 10% by weight of water; (3) stability against separation in the temperature range of 4°C. to 50°C.; (4) the use, i.e., effective to cleanse, moisturize and soften skin without a greasy after-feel when the composition is applied to and massaged into the skin, rinsed off with water and the skin is dried; and (5) additionally is characterized by being environmentally innocuous in use, particularly when the particulate mixture consists of starch and sodium chloride or vegetable seed flour or talc. Thus, the important characteristics of the claimed compositions are the paste or cream physical form of a skin cleansing and conditioning composition comprising a thickened mixture of emollient, surfactant and specific particulate mixture that is effective to cleanse and moisturize the skin in use and is stable against separation in the temperature range of 4°C. to 50°C. and environmentally innocuous.

Further, the generic claim defines the important parameters in order to obtain said desirable skin cleansing and conditioning compositions; i.e., (a) emollient material consisting of major proportion of emollient oil and a minor proportion of hydrophobic fatty material; (b) a controlled amount of a surfactant within the claimed range that leaves an emollient oil film in use without a greasy after-feel; (c) use of a magnesium or calcium C14 – C18 monocarboxylic acid salt in a proportion selected from claimed ratio range that is sufficient to thicken the emollient material and effective to produce a stable paste or cream; (d) use of the claimed proportion of particulate

materials that include 8% to 20% by weight of a starch material with another specific claimed particulate material and (e) 0% to 10% by weight a water.

The Claim Rejections "under 35 U.S.C. 103(a)" set forth in paragraphs 2 - 4 of the Office Action "as being unpatentable over Kellner in view of Barker et al. (of record)"are untenable and hereby traversed. Applicant maintains that "a person of ordinary skill in the art to which the subject matter pertains" would not agree with the Examiner's conclusion that Kellner et al. teaches the use of magnesium or calcium stearate in Kellner's "water and oil emulsion solid cosmetic composition (col. 1, lines 56-57 and the sole independent claim)."

More particularly, it is admitted that Kellner et al. states at column 2, lines 23-63, that the described water and oil emulsion solid compositions contain a "primary carboxylated salt gelling agent" as an essential ingredient and "Examples of gelling agents...are sodium...magnesium, or calcium salts of stearic...acids...." (Col. 2, 57-60) Because the description of the useable gelling agents does not describe the medium that is gelled by said primary gelling agent, one skilled in art would have to look at the exemplified compositions and discover that medium to be gelled was the continuous water containing phase of the oil-in-water emulsion stick of Example 1. Further examination of components of said example would reveal the continuous phase contained butylene glycol, sodium stearate, aluminum stearate (another gelling agent according column 2, line 59), PPC (a secondary gelling agent for water according col. 4, line et seq.) and a nonionic surfactant, said continuous phase being 66.55% of the composition with the mixture of water and butylene glycol representing 82.5% by weight of said continuous phase and the sodium stearate gelling agent 11.3% by weight of continuous phase. The dispersed oil phase of Example 1 consists of a mixture of dimethicone and cyclomethicone (col. 9, lines 48-49) gelled by mixture of synthetic wax, isostearyl alcohol and hydrogenated castor oil (col. 8, line 1, to col. 9, line 26), said dispersed

oil phase representing 24.7% by weight of the composition. Dispersed particulates consisting of a mixture of titanium dioxide, talc, nylon 12 and iron oxides and represent 7.18% by weight of solid stick of Example 1 with the remaining 1.62% by weight consisting of fragrance, antioxidants and skin conditioning agents. Based upon the foregoing detailed analysis of Example 1 of Kellner et al., the person of ordinary skill in art knows that sodium stearate is soluble in the aqueous continuous phase and effective to gel said phase upon cooling to 25 C from the mixing temperature of 85°– 90°C. Furthermore, a person of ordinary skill in art knows that the Kellner et al. taught equivalents of sodium stearate, i.e., magnesium and calcium stearate, are insoluble in the aqueous continuous phase and cannot gel said phase. Therefore a person of ordinary skill in art would know Kellner et al.'s teaching of equivalency of sodium stearate and calcium stearate or magnesium stearate is false and, thus, would be taught not to include calcium stearate and/or magnesium stearate in the disclosed compositions of Kellner et al.

As further proof of foregoing non-equivalency of sodium stearate and calcium stearate or magnesium stearate, the Examiner's attention is directed to enclosed Affidavit Two Under 1.132 of James McLaughlin wherein the affiant reproduced Examples 1 and 2B of Kellner et al. and obtained cosmetic stick compositions as shown in Exhibits A and C in said affidavit. However, when Mr. McLaughlin substituted calcium stearate for sodium stearate in accordance with the teachings of Kellner et al., he obtained grey liquid in reproduction of Example 1 (see affidavit Exhibit B) and a clear liquid with a white colored solid mass in reproduction of Example 2B (see affidavit Exhibit D). Thus, the enclosed Affidavit Two Under C.F.R. 1.132 is further proof of the fact known to a person of ordinary skill in art that Kellner at al.'s teaching that sodium stearate and calcium or magnesium stearate are equivalents as gelling agents for aqueous mediums is false.

Consequently, it is applicant's position that a person of ordinary skill in the art recognizing the falsity of Kellner et al.'s teaching of equivalency of sodium stearate and calcium stearate as gelling agents for aqueous mediums would be taught not to use calcium or magnesium stearate in the compositions of Kellner et al. Because the instant rejection based upon Kellner et al. as primary reference herein relies upon Kellner et al. for disclosure of calcium or magnesium stearate in cosmetic composition and no other cited reference shows calcium or magnesium stearate in a cosmetic composition, **the stated rejection is fatally defective and must be withdrawn by the Examiner because no reference shows applicant's essential calcium or magnesium stearate in a cosmetic composition.** In addition, the false teaching of Kellner et al. impacts on the credibility of Kellner et al. as a reference as set forth in the following discussion.

Further, a person of ordinary skill in art would note that all of examples of Kellner et al. were oil-in-water emulsion solid compositions with a continous aqueous phase and that all of exemplified compositions contained butylene glycol. Obviously, butylene glycol must be an essential ingredient in described oil-in-water emulsion solid compositions, but a person of ordinary skill in art would find that there is no mention of butylene glycol elsewhere in specification that consists of 23 columns. This glaring omission would further cause one of ordinary skill in art to doubt the completeness of the disclosure of Kellner et al.

Further facts reflecting adversely on credibility of the disclosure of Kellner et al. are (1) the disclosure and claims of Kellner et al. cover water-in-oil emulsion solid compositions and (2) no such water-in-oil emulsion solid compositions are exemplified. More specifically, a person of ordinary skill in art would know that sodium stearate was oil insoluble and could not gel the continuous oil phase and, therefore, one of ordinary skill in art would know that sodium stearate was not an essential component in water in oil emulsion compositions. While sodium stearate

could be used to gel the dispersed aqueous phase in water in oil emulsion solid compositions, Kellner et al. discloses a host of other aqueous phase gelling at column 2, line 66, to column 7, line 44, that could be used. With that knowledge, a person of ordinary skill in the relevant art would conclude that there was no need to include Kellner et al.'s primary carboxylated salt gelling agent (stated to be essential at col. 1, line 59, and in claim 1) in Kellner et al.'s water-in-oil disclosed cosmetic compositions. Also, one of ordinary skill in the art would note that no water-in-oil emulsion solid composition were exemplified and referring column 7, lines 51 – 60, of Kellner et al. would find that oil phase gelling agents form a soft gel, not a solid stick, in 1:1 weight ratio to the oil phase. Since the aqueous phase gelling agent has no power to gel the continuous oil phase, a person of ordinary skill in art would not know how to attain a water-in-oil emulsion solid stick composition following the teachings of Kellner et al.

In view of shortcomings of the disclosure of Kellner et al.'s discussed above, a person of ordinary skill in the relevant art would have serious questions about the credibility of Kellner et al.'s entire disclosure and would reasonably conclude that the credible disclosure is limited to exemplified compositions and the parts of the specification that specifically pertain to said exemplified compositions. A person of ordinary skill in the relevant art certainly would ignore such language as "The term 'solid' means...solid or semi-solid...." (col. 2, lines 7-8) and "Also included within the definition of 'stick' are anhydrous compositions...." (col. 2, lines 14-15). Thus, the disclosure in the primary reference of Kellner et al. is not entirely credible and the credible portions of Kellner et al. do not support the Examiner's stated rejection of applicant's invention. RHM

The addition of Barker to Kellner et al. does not remedy the shortcomings of that reference discussed above. Barker discloses and claims a relevant composition in the form of a cleansing cream containing a "base of edible oil and/or petroleum jelly" with granules of an "inorganic non-

irritating salt... sodium chloride... salt of vitamin" uniformly distributed therein (col. 1, lines 56 – 65) and Example I describes a composition containing 20% by weight of sodium chloride particles distributed in 80% by weight of a base of equal proportions of corn oil and petroleum jelly. Barker's composition is relevant because it is in the form of a cream containing two of Applicant's six essential ingredients, i.e., emollient oil and particulate sodium chloride. However, Barker 's compositions do not contain Applicant's water-insoluble carboxylic acid salt thickener ingredient or applicant's essential surfactant ingredient or applicant's starch ingredient. Applicant made reference to Barker in the specification (page 3, lines 20 – 23, and in Example 16) and directs the Examiner's attention to Applicant's Example 16 wherein Applicant reproduced Barker's Example I with stated result that Barker's composition is not stable because the sodium chloride precipitated in less than one hour. Applicant admits that Barker discloses the use of sodium chloride in cleansing composition that is not useful because the resultant composition is not stable. Barker alludes to the stability problem at column 3, lines 30-37, wherein his solution to stability problem is to keep the cream and salt particles separate and in use dipping the fingers into the emollient cream and then into the salt particles thereby forming the composition on the fingers before applying said composition to the skin. Thus, Barker is pertinent because it discloses incorporation of sodium chloride in an emollient material is a problem because the resultant composition is unstable. Therefore, Barker is further evidence that Applicant's stable cream compositions containing a particulate sodium chloride are novel and unobvious.

In paragraphs 6 and 7 of the Office Action "Claims 7 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner ... in further view of McAtee et al. (US 6,153,208, claim 7) and Touzan et al. (US 6,033,647, claim 38, 39)." McAtee et al., like Kellner, relates to non-analogous subject matter, i.e., a single use, disposable cleansing and conditioning article

comprising a water insoluble paper layer (col. 12, line 30) joined to a second layer of woven or non-woven materials (col. 14, lines 44 – 55) impregnated with at least one surfactant and a conditioning material, e.g., an emollient material. The article is dry prior to use and is designed to generate a foam when wetted with water in use (col. 5, lines 1 – 4). Again, common denominator is that McAtee's dry, impregnated pad and Kellner's water and oil emulsion solid stick are applied to the skin, but neither reference is relevant to Applicant's skin compositions in the form of a paste or cream that contains a suspension of particulate material to cleanse the skin and controlled proportions of emollient and surfactant designed to leave a film of emollient material on the skin when the composition has cleaned the skin and is rinsed from the skin. Again, Applicant maintains that the inventive paste or cream composition is unlike the two layer cleaning pad of McAtee et al. or pigmented solid stick of Kellner and a person of ordinary skill in the relevant art would not consult either reference in designing applicant's paste or cream composition for cleansing and conditioning the skin. Thus, the reference combination is not suggested by the references themselves, but is based 20/20 hindsight reconstruction of prior art by the Examiner.

The Examiner relies upon McAtee et al. for its disclosure of sodium cocoyl methyl taurate at column 20, lines 1 – 13, as anionic lathering surfactant for use in the article of McAtee et al. Applicant acknowledges the fact sodium cocoyl N methyl taurate is a foaming anionic surfactant.

Touzan, like McAtee et al., discloses non-analogous self foaming cream composition for treating the hair or skin comprising an oil in water emulsion gelled with an emulsifying polymer (col. 2, lines 29 – 55) that is pressurized with a propellant gas (col.6, lines 44 – 54) and that is delivered in form of cream that foams when spread on the skin (col. 2, lines 61 – 65). The exemplified compositions contain 74 – 75% by weight of water and less than 2% by weight of surfactant and are unlike either Applicant's cream or paste containing 0 – 10% by weight of water

or Kellner's exemplifed oil in water emulsion solid stick compositions containing 37% - 50% by weight of water. Touzan is cited by the Examiner for its disclosure of the use of macadamia oil in composition that is applied to skin. Again the reference combination of Kellner et al.'s water and oil emulsion solid stick with Touzan's aerosol water and oil emulsion liquid is not suggested by references themselves and is unlike applicant's paste or cream mixture of emollient, surfactant and particulate cleaning mixture. Again, the reference combination is only based upon the Examiner's 20/20 hindsight reconstruction of the prior art in view of applicant's invention, an invalid ground of rejection.

In summary, the foregoing discussion proves that cited references to Barker et al., McAtee et al. and Touzan et al. do not remedy the shortcomings of the primary Kellner et al.reference set forth above, e.g., no credible disclosure of an insoluble C14 – C18 monocarboxylic acid as thickening agent in applicant's claimed cream or extrudable paste compositions for cleansing and conditioning the skin of the user. In fact, the credible portion of disclosure of Kellner et al. teaches one of ordinary skill in the art not to use calcium or magnesium stearate in the compositions of Kellner et al. for any purpose. Thus, the rejection herein based upon Kellner et al. as the primary reference is fatally defective because it does not disclose or suggest applicant's claimed compositions in accordance with 35 U.S.C 103(a) and must be withdrawn.

Rebuttal to Examiner's Response To Applicant's Arguments

With respect to point 1, the Examiner is reminded that the compositions of Kellner et al. and applicant exhibit the following differences:

1. Kellner relates to "a water and oil emulsion solid cosmetic composition" (col. 1, lines 56-57, and claim 1) whereas applicant relates a non emulsion composition.

2. Kellner's compositions are in the form of a stick or solid according to his six stated objects (col.1, lines 36-53) and not two as erroneously stated by Examiner; whereas applicant's compositions are in form of cream or extrudable paste.
3. Kellner's exemplified compositions are characterized as solid emulsions containing a continuous aqueous phase gelled by sodium stearate and a dispersed gelled oil phase with particulate matter suspended therein; whereas applicant's exemplified compositions are characterized by a mixture oil and surfactant thickened with calcium stearate with particulate mixture containing starch and another particulate suspended therein.
4. Kellner's compositions are designed to apply color to the skin (claim 1) whereas applicant's compositions are designed to cleanse and condition the skin.

In summary, the compositions of Kellner and applicant differ (1) in form, i.e., solid stick vs. cream/paste; (2) chemical nature, i.e., water and oil emulsion vs. liquid containing suspended solids; (3) composition, i.e., aqueous phase gelled by soluble sodium stearate vs. oil phase thickened with insoluble calcium or magnesium stearate; and (4) use, i.e., apply materials to the skin vs. cleanse the skin and apply conditioning agents to the skin. Therefore, it is submitted that a person of ordinary skill in art would recognize that compositions of Kellner et al. and applicant are different and would not consider Kellner to be valid reference against applicant's inventive compositions.

Furthermore, a person of ordinary skill in the cosmetic art knows that Kellner's teaching of equivalence of sodium stearate and calcium or magnesium stearate is false. Applicant's two Affidavits Under C.F.R. 1.132 of record are further proof that Kellner's foregoing teaching of said equivalence is false. Consequently, a person of ordinary skill in relevant would question the

credibility of the disclosure of Kellner et al. Then when a person of ordinary skill noted that all of all exemplified compositions of Kellner et al. contained butylene glycol --an apparent essential ingredient that is nowhere discussed in specification--and further noted the absence of an exemplified composition in the form of water-in-oil emulsion solid , the credibility of the disclosure of Kellner et al. would be further compromised. Upon further reflection of need for a primary gelling agent for the dispersed aqueous phase in a water-in-oil emulsion composition disclosed by Kellner et al., it is apparent a person of ordinary skill in relevant art would conclude that the credible disclosure is limited to what is shown by the exemplified compositions.

For the record, the following statements of the Examiner appearing at page 5 of the latest Office are noted and require further explanation by the Examiner:

a. "With respect...35 U.S.C. 103...what reference...would have suggested...including unpreferred embodiments...." The relevant statute uses term "obvious from," not "suggested by." **Question 1 for the Examiner is: Does "suggested by" have the same meaning as "obvious from"? Question 2 for the Examiner: Do the words "unpreferred embodiment" include "inoperable embodiments"?** The answers to foregoing questions are needed to clarify the Examiner's rejection herein.

b. "However, what applicant demonstrated is moot in view of the fact that the cosmetic composition disclosed by Kellner comprises other ingredients, such oil, surfactant, which may well affect the gelling properties of the composition." **Applicant specifically requests the Examiner as a person of ordinary skill in relevant art to make detailed analysis of Example 1 of Kellner et. al. with calcium stearate substituted for sodium stearate and state for record what ingredient(s) gel the continuous aqueous phase to form the stated "oil-in-water emulsion stick."**

c. "Further, one of ordinary skill in the art would not have interpretated Kellner's teaching as sodium stearate and calcium stearate are exactly the same." Applicant refers the Examiner to column 2, lines 57-60, where Kellner at al. states as follows: "Examples of gelling which may be used in the compositions of the invention are sodium,... calcium salts of stearic... acids...." A person of ordinary skill in the relevant art would understand that language with reference Example 1 of Kellner et al. to state that the stated salts gel aqueous phase of Kellner's compositions, but calcium stearate does not gel said aqueous phase as shown by applicant's two Affidavits Under 37 C.F.R. 1.132. **If the Examiner does not agree, the Examiner is requested to state for record whether the sentence appearing at col. 2, lines 57-60, is true or false or ambigious.**

Based upon 20/20 hindsight, applicant's attorney concludes the credibility problems associated with the disclosure of Kellner et al. herein are the result of four inventors and their attorney claiming a narrow invention too broadly and the Assistant Examiner and Primary Examiner (whose names appear on page 1 of Kellner et al.) examining said application did not have the knowledge of a person of ordinary skill in the relevant art. See In re Berg, 65 U.S.P.Q. 2nd 2003 (Fed. Cir. 2003). Applicant's attorney thinks that the Examiner should realize that the grant of the patent to Kellner et al. in its present form represents "a mistake by U.S. Patent Office" that should not be perpetuated.

Again, for the record, the decisions In re Wertheim, 541 F.2d 257, 191 USPQ 90, and In re Woodruff, 919 F.2d 1575, 16 USPQ 1934, are not applicable to facts presented in the instant application and the decision in Ex parte Winters, 11 USPQ2nd 1387, is rebutted by superior conditioning properties of claimed compositions set forth in Table I at page 18 of Applicant's

specification versus the recognized competitive products currently in the marketplace. The decisions in In re Keller, 642 F.2nd 413, 231 USPQ 871 (CCPA) and In re Merck & Co., 800 F.2nd 1091, 231 USPQ 375 (Fed. Cir. 1986), are noted but not relevant to the rejection herein where as proved herein that the primary reference teaches a person of ordinary skill in art against the inclusion of one applicant's essential claimed ingredients and no other reference teaches the use of said ingredient in a relevant cosmetic composition. Finally, according to the express terms of 37 C.F.R. 1.132, an affidavit thereunder is proper to traverse a rejection based upon a cited reference.

In conclusion, Applicant has invented a novel and useful skin cleansing and conditioning composition that is new, useful and unobvious from any fair combination of the references cited by the Examiner or PCT search. Further, the claimed compositions in use are very effective according to evaluation set forth in the Table following Example 1 and are environmentally innocuous. Accordingly, the claimed compositions are in accord with U.S.C. 101 – 103 and early allowance of claimed invention is respectfully solicited. Furthermore, in view of the record herein, applicant's attorney requests the Examiner to have the primary examiner review the file herein, particularly this reply, if the Final Rejection is not withdrawn.

If the Examiner has any questions about the foregoing response, the Examiner is urged to make collect phone call to the undersigned attorney at (973) 338-4660.

Respectfully submitted,

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Enc. Affidavit Two Under 37 CFR 1.132